

REMARKS

In the outstanding Final Office Action, claims 1-3, 5-12, and 14-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maeda et al. (U.S. Patent No. 6,785,487, "Maeda") in view of Bodnar (U.S. Patent No. 6,544,295, "Bodnar"); and claims 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maeda in view of Bodnar, and further in view of Funaki (U.S. Patent No. 6,707,471, "Funaki").

Independent claim 1 recites, *inter alia*, that "when there is an input to operate the OK button," (1) "the inputted setting of the image forming condition is enabled" and (2) "a shortcut button is displayed on the initial screen." Along the same lines, independent claim 12 recites, *inter alia*, "when the input to operate the OK button is received," (1) "enabling the inputted setting of the image forming condition" and (2) "displaying a shortcut button on the initial screen." Applicants submit that the claimed OK button thus has two functions, and is more convenient than separate buttons each having a single function. For example, the claimed OK button can be particularly useful because it can obviate the need for a user to have to operate the image forming apparatus just for creating a shortcut button, since a shortcut button can be created while enabling the input setting of the image forming condition.

Applicants submit that neither Maeda nor Bodnar teaches or suggests an OK button having all of the aforementioned features of independent claims 1 and 12, and thus that claims 1 and 12 are patentable over Maeda and Bodnar, whether taken alone or in combination.

First, Applicants submit that Maeda does not teach or suggest an OK button having any one, much less both, of the aforementioned features. Consistent with Applicants' position, the Office Action concedes at page 2 that "Maeda does not explicitly disclose the setting screen includes an OK button for enabling the setting of the image forming condition inputted on the setting screen" and at page 6 that "Maeda does not explicitly disclose receiving an input to operate an OK button so as to display a short cut button on the initial screen and enable the setting of the image forming condition inputted on the setting screen."

Second, Applicants submit that Bodnar does not teach or suggest at least that "when there is an input to operate the OK button . . . the inputted setting of the image forming condition is enabled." The Office Action asserts at pages 2-3 that "Bodnar discloses . . . an OK button for creating a shortcut represented by an icon on an initial screen (column 11, lines 25-45)." However, Applicants submit that even though Bodnar discloses that "[t]he user clicks OK in the Create Internet Shortcut dialog box" and that this "creates [an Internet Shortcut], represented by an icon, which appears on the user's desktop" (c. 11, ll. 28-31), Bodnar still fails to teach or suggest at least that "when there is an input to operate the OK button . . . the inputted setting of the image forming condition is enabled." Bodnar's Internet Shortcut is created as follows. First, "the user right-clicks a Web site . . . , and then selects 'Internet Shortcut' from the pop-up menu" (c. 11, ll. 26-28). Then, "[t]he user clicks OK in the Create Internet Shortcut dialog box" (c. 11, ll. 28-29). Thus, to the extent that Bodnar discloses an "OK button" that creates an Internet Shortcut, that button is the "OK" clicked by the user in Bodnar's Create Internet Shortcut dialog box. But although clicking OK in that dialog box may create an

Internet Shortcut icon, it performs no other function, and in particular does not enable the setting of an image forming condition. Therefore, whatever “OK button” Bodnar may disclose fails to meet the claimed “OK button,” with all of its features, which “OK button” is not taught or suggested by Meade either, and thus Applicants respectfully submit that claims 1 and 12 are patentable over Maeda and Bodnar.

Finally, Applicants respond to several other assertions made in the Office Action as follows. The Office Action asserts at page 3 that “it would have been obvious . . . to include an OK button for enabling the setting of the image forming condition inputted in Maeda, because including an OK button was recognized as part of the ordinary capabilities of one skilled in the art.” Applicants respectfully disagree, and submit that the issue is not whether a mere “OK button” without more was recognized as part of the ordinary capabilities of one skilled in the art, but rather whether an OK button *with each and every one of its claimed features* was so recognized. In this regard, and for the foregoing reasons, Applicants submit that Maeda does not teach an OK button having any of the OK button’s claimed features and that Bodnar’s alleged “OK button” lacks at least any feature pertaining to the setting of an image forming condition. Further, the Office Action asserts at page 10 that “Bodnar is incorporated to teach the functionality of an OK button which confirms a setting of an image forming condition (shortcut creation).” In response, Applicants submit that Bodnar’s clicking of “OK” pertains solely to the creation of an Internet Shortcut, that this has nothing to do with the setting of an image forming condition, and that Bodnar fails to teach or suggest an OK button having any function pertaining to an image forming condition, which has nothing to do with the “methods for managing a user’s own preferred Internet sites in a computer system”

context of Bodnar (c. 1, ll. 18-20). Furthermore, the Office Action asserts at page 11 that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” In response, Applicants submit that Applicants have not attacked the references individually but rather have argued that the none of the references teach certain claimed features (see Reply to Office Action filed March 26, 2008, pp. 8-9) and thus that “Maeda and Bodnar, whether taken alone or in combination” (Reply to Office Action filed March 26, 2008, p. 10, emphasis added), fail to teach or suggest all the features of amended independent claims 1 and 12.

For the foregoing reasons, Applicants submit that neither Maeda nor Bodnar teaches or suggests that “when there is an input to operate the OK button,” (1) “the inputted setting of the image forming condition is enabled” and (2) “a shortcut button is displayed on the initial screen,” as recited in independent claim 1 and similarly recited in independent claim 12. Therefore, whether taken alone or in combination, Maeda and Bodnar fail to teach or suggest all the features of independent claims 1 and 12. Accordingly, Applicants respectfully request favorable reconsideration of the rejection of independent claims 1 and 12 and their dependent claims 2, 3, 5-11, and 14-19 as being unpatentable over Maeda in view of Bodnar.

Applicants further submit that Funaki fails to teach or suggest the aforementioned features of independent claims 1 and 12 not taught or suggested by Maeda and Bodnar. Therefore, whether taken alone or in combination, Maeda, Bodnar, and Funaki fail to teach or suggest all the features of independent claims 1 and 12. Accordingly, Applicants respectfully request favorable reconsideration of the rejection of claims 20

and 21, which depend from one of claims 1 and 12, as being unpatentable over Maeda in view of Bodnar, and further in view of Funaki.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art. Applicants therefore request favorable reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Because the Office Action contains characterizations of the claims and prior art with which Applicants do not necessarily agree, Applicants decline to subscribe to any such characterizations unless expressly set forth in this paper.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 9, 2008

By: /David W. Hill/
David W. Hill
Reg. No. 28,220